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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/260,536 06/16/94 LORENCE

R 57704

EXAMINER

SCHEINER, L

ART UNIT

PAPER NUMBER

22

18N1/0709

JOHN W. RYAN, ESQ.

IGEN, INC.

16020 INDUSTRIAL DRIVE

GAITHERSBURG, MARYLAND 20877

1813

DATE MAILED:

07/09/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 4/19/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474..
6. _____

Part II SUMMARY OF ACTION

1. Claims 13-140 are pending in the application.

Of the above, claims 22, 25, 37, 39-42, 44-47, 50-63, 65, 66, 68, 70-105, 109, 110, 112-116, 118, 119, 121-124, 126, 127, 129-132 & 135-137 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 13-18, 23, 24, 26, 35, 36, 38, 43, 48, 64, 67, 69, 106-108, 111, 125, 133, 134 & 14 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

BEST AVAILABLE COPY

Art Unit: 1813

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Newly submitted claims 22, 25, 37, 39-42, 44-47, 50-63, 65, 66, 68, 70-105, 109, 110, 112-116, 118, 119, 121-124, 126, 127, 129-132, and 135-139 are directed to an invention that is independent or distinct from the invention originally claimed since the scope of the new claims differs due to the limitations set forth. Also, the new limitations may not be supported by the original disclosure.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22, 25, 37, 39-42, 44-47, 50-63, 65, 66, 68, 70-105, 109, 110, 112-116, 118, 119, 121-124, 126, 127, 129-132, and 135-139 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Applicants fail in particularly pointing out a specific basis for the newly recited "mesogenic strain". Please see MPEP 608.04(a) and 706.03(o). The recitation is considered to be new matter since support is lacking.

Claims 23, 43, 64, 106-108, 111, 125, 133, and 140 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-18, 24, 35, 36, 38, 48, 67, 69, and 134 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bohle et al for reasons of record.

Claims 13-18, 24, 35, 36, 38, 48, 67, 69, and 134 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Cassel et al for reasons of record.

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Claims 13-18, 24, 35, 36, 38, 48, 67, 69, and 134 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Murray et al for reasons of record.

Applicants' arguments regarding the rejection under 35 U.S.C. § 112, first paragraph is acknowledged, however, it is not convincing for the reasons set forth in the previous Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner whose telephone number is (703) 308-1122.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is (703) 305-7939.

L.A.
Laurie Scheiner/LAS
July 6, 1996

L.A. 7.6.96
LAURIE A. SCHEINER
PATENT EXAMINER
GROUP 1800